

REMARKS

In response to the Official Action mailed January 11, 2006, Applicants amend their application and request reconsideration. Claims 1-27 stand rejected. In this Amendment, no claims are added or canceled. Claims 3, 11, 19, and 25-27 are amended without the addition of new matter. Claims 1-27 remain at issue.

I. 35 U.S.C §103(a) Obviousness Rejection of Claims

Claims 1-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Rybicki et al.* (U.S. Patent No. 5,630,081, hereinafter “*Rybicki*”) in view of *Kucala* (U.S. Patent No. 5,832,489). Applicants respectfully traverse this rejection and respectfully request reconsideration.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. MPEP §2143. The rejection of claim 1 under §103(a) is improper as the combination of *Rybicki* and *Kucala* does not teach or suggest all of the claim limitations. For example, the combination fails to teach or suggest the following limitations:

- *creating an original document on a computer*
- *transferring said original document to a disconnected device, wherein said disconnected device is a portable electronic device capable of performing computations at any location*
- *modifying said original document on said disconnected device to form a modified document*
- *returning said modified document to said computer.*

The Examiner asserts that these limitations are taught by *Rybicki* at col. 1, lines 15-25, which states:

The personal computer revolution has placed computers in the offices and briefcases of business travelers. Portable computers known as laptop, notebook, or palm-top PC's allow the traveler to continue working while on the road or on the plane. Upon returning to the office, files created or

modified on the portable PC must be transferred to a desktop computer at the office. Special software programs have been designed for transferring and synchronizing files between a portable and a stationary desktop computer. One such program is marketed under the name "LapLink™" by Traveling Software, Inc. of Bothell, Wash.

With respect to this passage, the Examiner contends "the fact that portable computers known as laptop, notebook, or palmtop PC allow the traveler to continue working while on the road or on the plane as in his/her office inherently shows that the original documents are created at the desktop computer at his/her office." (See page 3 of the Official Action). Applicants respectfully note that *Rybicki* merely discloses the synchronizing of files, and does not even once mention a document, as recited by claim 1. Accordingly, *Rybicki* fail to teach or suggest the above limitations, as alleged by the Examiner.

Furthermore, the combination of *Rybicki* and *Kucula* fails to teach or suggest, for example, *determining by the computer one or more modifications between the original document and the modified document*, as recited by claim 1. The Examiner asserts that this limitation is taught by *Kucula*. However, *Kucula* mere discloses determining new, updated, or deleted records in a calendar file. (See column 4, lines 7-12 of *Kucula*). A calendar file cannot be construed as a "document" within the context of the present application. Moreover, determining modifications between documents is a wholly different endeavor than reconciling calendar records, and thus *Kucula* cannot even suggest this limitation. Because neither *Rybicki* nor *Kucula* explicitly or implicitly teaches or suggests determining modifications between an original document and a modified document, *prima facie* obviousness has not been established, and the rejection should be withdrawn.

Claims 9 and 17 recite limitations similar to claim 1, and are thus patentable for at least the same reasons as given for claim 1. Claims 2-8, 10-16, and 18-27 depend from claims 1, 9,

and 17, respectively, and are therefore patentable for at least the same reasons as given for claims 1, 9, and 17.

Amended claim 3 is patentable over *Rybicki* and *Kucula* also because the combination of the two fails to teach or suggest *determining whether change tracking software on said disconnected device is compatible with the change tracking software on said computer, and if the change tracking software on said disconnected device is not compatible with the change tracking software on said computer, utilizing a data translation operation to convert tracked changes to a protocol useable by said computer*. Nothing in either reference teaches or suggests this limitation. Amended claims 11 and 19 recite similar limitations and are therefore patentable for at least the same reasons as given for claim 3.

Amended claim 25 is patentable over *Rybicki* and *Kucula* also because the combination of the two fails to teach or suggest identifying differences between said original document and said modified document using change tracking software on the disconnected device. *Rybicki* does not identify differences in a document at all, as the Examiner conceded that *Rybicki* does not teach determining one or more modifications. *Kucula* discloses reconciling differences in a calendar file, but fails to teach or suggest change tracking software on the palmtop computer. In *Kucula*, the modified calendar file is compared, by the original PC and by the palmtop, to a backup calendar file stored on the PC. (See column 4, lines 4-12 of *Kucula*). Thus, the combination of *Rybicki* and *Kucula* fails to teach or suggest, at least, change tracking software on the disconnected device. Amended claims 26 and 27 recite similar limitations and are therefore patentable for at least the same reasons as given for claim 25.

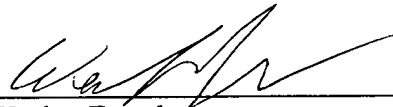
CONCLUSION

In view of the above amendments and remarks, Applicant submits that all claims are allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

Dated: April 6, 2006

By: _____


A. Wesley Ferrebee
Registration No. 51,312

Customer Number: 58328
SONNENSCHN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
Telephone: (202) 408-9214
Facsimile: (312) 876-7457